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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  NEN-22102/16
	Application Number 10/563,347-Conf. #8834	Filed January 3, 2006
	First Named Inventor Richard A. Joseph et al.	
	Art Unit 1634	Examiner J. Martinell
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>50,434</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;">   <hr style="border: 0; border-top: 1px solid black; margin: 5px 0;"/> <p>Signature</p> <hr style="border: 0; border-top: 1px solid black; margin: 5px 0;"/> <p>Julie K. Staple Typed or printed name</p> <hr style="border: 0; border-top: 1px solid black; margin: 5px 0;"/> <p>(734) 913-9300 Telephone number</p> <hr style="border: 0; border-top: 1px solid black; margin: 5px 0;"/> <p>July 24, 2009 Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below".</p>		
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.		

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of: Richard A. Joseph et al.

Application No.: 10/563,347

Confirmation No.: 8834

Filed: January 3, 2006

Art Unit: 1634

For: ASSAY AND PROCESS FOR LABELING  
AND DETECTION OF MICRO RNA AND  
SMALL INTERFERING RNA SEQUENCES

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Examiner: J. Martinell

**PRE-APPEAL BRIEF ARGUMENTS**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action mailed April 24, 2009, and the subsequent Advisory Action mailed June 5, 2009, Appellant hereby submits a Notice of Appeal accompanied by a Pre-Appeal Request for Review. Pre-Appeal Brief arguments are below for the consideration of the review panel.

**Rejection of Claims 15-19 Under 35 USC §102(b)**

Claims 15-19 stand rejected under 35 USC §102(b) as being anticipated by Dale et al. (WO 00/070093).

The Examiner asserts that Dale et al. disclose microarrays that include all the limitations mentioned in the instant claims. In particular, Dale et al. is cited as disclosing "arrays having a plurality of modified oligonucleotides (page 15, line 32 through page 17, line 25), use of non-unique oligonucleotides (page 20, lines 18-28), use of several different types of sequences (page 19, line 27 through page 20, line 17), duplicate synthesis for regions of redundancy (page 18, lines 12-17) and the use of control sequences (e.g. page 19, lines 4-14)."

A claim is anticipated under 35 USC §102(b) "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Further, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See also MPEP 2131.

Despite the Examiner's assertions, Applicant submits that the Dale et al. reference does not appear to disclose all aspects of claims 15-19. In particular, Applicant finds no apparent disclosure relating to at least two capture oligonucleotides on a substrate wherein the capture oligonucleotides each include a control or spacer nucleotide sequence and at least two replicates of a nucleotide sequence complementary to a first or second short RNA fragment.

Applicant notes that the present claims indicate that a capture oligonucleotide has at least two replicates of a nucleotide sequence complementary to a first short RNA fragment and has an additional control or spacer nucleotide sequence. In other words, each single oligonucleotide contains the two replicates and the control or spacer. Applicant finds no disclosure of a capture oligonucleotide containing two replicates of a nucleotide sequence complementary to a first short RNA fragment and a control or spacer in any of the references cited.

In view of the lack of disclosure of all aspects of the present claims, Applicant submits that claims 15-19 are not anticipated by Dale et al. and respectfully request withdrawal of this rejection and allowance of the claims.

#### **Rejection of Claims 20, 21 and 24 Under 35 USC §103(a)**

Claims 20, 21 and 24 stand rejected under 35 USC §103(a) as being obvious over Dale et al. (WO 00/070093) in view of Houthoff et al. (U.S. Patent No. 6,133,038).

In view of Applicant's belief as to the allowability of independent claim 15, claims 20, 21 and 24, which include all aspects of claim 15, are likewise submitted to be allowable. Applicant submits that these claims encompass patentable subject matter separate from claim 15. Applicant reserves the right to make such remarks of record in the event that the rejection is maintained.

Dated: July 24, 2009

Respectfully submitted,

By 

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